

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Patent Application of: |) | Confirmation No.: 6014 |
| Shunpei YAMAZAKI |) | Examiner: Bilkis Jahan |
| Serial No. 10/590,271 |) | Group Art Unit: 2814 |
| Filed: August 22, 2006 |) | |
| For: ID CHIP AND IC CARD |) | |

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Honorable Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

The present *Request* is filed pursuant to the provisions of the Pre-Appeal Brief Conference Pilot Program (1296 Off. Gaz. Pat. Office 67 (July 12, 2005); extended January 10, 2006). The Official Action mailed November 10, 2010 and the Advisory Action mailed February 22, 2011 have been received and their contents carefully noted. Filed concurrently herewith is a *Notice of Appeal* and a *Request for One Month Extension of Time*, which extends the shortened statutory period for response to March 10, 2011. Accordingly, the Applicant respectfully submits that this response is being timely filed.

The Applicant requests review of the final rejection in the above-identified application. Because Applicant's February 10, 2011 Amendment was indicated as being enterable upon filing of a *Notice of Appeal*, no further amendments are being filed with this request. The Official Action includes improper rejections, errors in fact and omissions of essential elements required to establish a *prima facie* rejection.

Claims 1-16 are pending in the present application, of which claims 1-8, 10, 12 and 13 are independent. For the reasons set forth in detail below, all claims are believed to be in condition for allowance. Favorable reconsideration is requested.

The Official Action rejects independent claims 1-8, 10, 12 and 13 as obvious based on U.S. Publication No. 2003/0032213 to Yonezawa alone or in view of various combinations of U.S. Patent No. 4,695,859 to Guha, U.S. Publication No. 2002/0149119 to Kumatani, U.S. Publication No. 2003/0052324 to Kimura, and/or U.S. Patent No. 6,590,633 to Nishi. The Applicant respectfully traverses the rejections because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

With respect to independent claims 1-3, 5-7, 10 and 13, these claims recite the feature "wherein the integrated circuit includes a power supply circuit **configured to generate** a power supply voltage from an alternating voltage generated by the antenna." Support for this feature can be found, for example, in Applicant's specification on page 2, lines 19-27.

Applicant's February 10, 2011 Remarks are incorporated herein by reference. In summary, Applicant argued that the Patent Office failed to meet its burden in establishing that Yonezawa taught the alleged features. In particular, even if the conclusory statements in the Office Action were true, the Patent Office has failed to establish any connection between the alleged antenna 2708 in the cell phone example in Yonezawa and the alleged power supply line (Vi) that would have enabled the power supply circuit to be configured to generate a power supply voltage "from an alternating voltage generated by an antenna," as recited in the claims.

The Advisory Action appears to ignore this claimed "configured to" recitation alleging that it is functional and "Yonezawa discloses all structural limitations which is [sic] function as a claimed feature." It is further alleged in the Advisory Action that it is "common in the art that the antenna has to be connected with the power supply line in

order to function [sic] the antenna." Applicant respectfully disagrees and asserts that the proper legal standards of obviousness have not been applied.

As set forth in MPEP § 2173.05(g), "[t]here is nothing inherently wrong with defining some part of an invention in functional terms." Moreover, a "functional limitation must be evaluated and considered, just like any other limitation...for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used." See also In Innova/Pure Water Inc. v. Safari Water Filtration Sys. Inc., 381 F.3d 111, 1117-20, 72 USPQ2d 1001, 1006-08 (Fed. Cir. 2004) where the court noted that a term used to reflect a functional relationship between claimed components means the components "must be connected in a way to perform a designated function." A case more closely on point may be Ex parte Tipley, (Appeal 2009-000300) decided by the Board of Patent Appeals and Interferences on September 18, 2009 (copy attached). In Tipley, a rejection of claims directed to a circuit board "configured to move in a first direction" were reversed because there was no reasoning in the rejection to support a finding that the reference's structure "inherently moves" as claimed. See also In re Schreiber, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997) where a reference silent as to a certain function was found to anticipate because it was determined that limitations at issue were inherent in the prior art reference.

Thus, while MPEP § 2114 suggests that claims directed to an apparatus are distinguished from the prior art in terms of structure rather than function, the above MPEP sections and case law precedents make clear that functional language may not be ignored but must instead be considered to properly assess patentability, at least in so far as to find and identify prior art structure capable of "inherently" performing the claimed functionality. That is, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Rather, "[t]o establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill...The mere

fact that a certain thing may result from a given set of circumstances is not sufficient.' " In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).

In the present case, the identified structure in Yonezawa of a loosely identified antenna 2708, an alleged power supply line (Vi) as a power supply circuit and pure speculation as to their structural and functional operation are insufficient to establish that the claimed functionality is "inherently" achieved by this structure. Instead, if anything, to the contrary, if the cell phone in Yonezawa were capable of generating a power supply voltage from an alternating voltage generated by the antenna as alleged, a cell phone would not require a separate battery source. Moreover, while the power supply line Vi in Yonezawa may transmit power, it is not expressly taught to generate a power voltage, and clearly does not provide an enabling disclosure for how power could be generated from the loosely identified antenna 2708 only shown generally in the figures.

Thus, consistent with the Tipley Board decision, mere recitation of loosely coupled structure and speculation as to how the structure may be connected or operate should be found insufficient rationale to support a finding of anticipation or obviousness of the claimed "configured to" functionality. Accordingly, the Patent Office has failed to meet its burden to support that Yonezawa's alleged structure necessarily achieves the claimed functionality. The various secondary references fail to overcome the deficiencies of Yonezawa with respect to independent claims 1-3, 5-7, 10 and 11.

Regarding independent claims 4, 8 and 12, these claims recite "a rectification circuit **configured to rectify an alternating voltage generated by an antenna.**" In support of this feature, the Official Action again relies on teachings of Yonezawa, in particular, antenna 2708 and power supply line (Vi). For reasons similar to those discussed above with respect to the other independent claims, the Patent Office has not established any connection between the alleged antenna 2708 and any rectification circuit in Yonezawa that would have been inherently structurally interconnected to necessarily achieve the recited "configured to" functionality of rectifying an alternating voltage generated by the antenna, or generating a power supply voltage from voltage

outputted from the rectification circuit, as claimed. The various secondary references fail to overcome the deficiencies of Yonezawa with respect to independent claims 4, 8 and 12. Because there is insufficient rationale provided to establish that the alleged structure is inherently capable of achieving the claimed functionality, the Patent Office has failed to meet its burden.


Because Yonezawa, alone or in view of secondary references, does not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained with respect to independent claims 1-8, 10, 12 and 13. Therefore, Applicant believes the rejections of claims 1-8, 10, 12 and 13 and claims dependent therefrom are not proper.

For the reasons stated above, the Official Action has not formed a proper *prima facie* case of obviousness. Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c) and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,



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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROGER E. TIPLEY,
ARTHUR G. VOLKMANN,
BARRY S. BASILE, and
STEVE L. RADABAUGH

Appeal 2009-000300
Application 11/108,338
Technology Center 2800

Decided: September 18, 2009

Before CATHERINE Q. TIMM, MICHAEL P. COLAIANNI, and
JEFFREY B. ROBERTSON, *Administrative Patent Judges*.

COLAIANNI, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 9 through 29, which are all of the claims pending in the above-identified application. We have jurisdiction pursuant to 35 U.S.C. § 6.

We REVERSE.

STATEMENT OF THE CASE

The subject matter on appeal is directed to, *inter alia*, a computer system. Claim 9 is illustrative:

9. A computer system comprising:

a first circuit board comprising a first connector;

a second circuit board disposed at an angle relative to the first circuit board and having a second connector couplable to the first connector, wherein the second circuit board is configured to move in a first direction along the first circuit board to generally align the first and second connectors; and

a mechanism configured to engage the second circuit board, such that the second connector moves in a second direction along a curved path between an engaged position coupled to the first connector and a disengaged position offset from the first connector, wherein the first direction is substantially transverse to the second direction along the curved path.

The Examiner rejects claims 9-12 and 17-29 under 35 U.S.C. § 102(b) as anticipated by Grabbe (US 4,370,012, published Jan. 25, 1983) and claims 13-16 under 35 U.S.C. § 103(a) as unpatentable over Grabbe in combination with Tondreault (US 5,769,668, published Jun. 23, 1998), Obermaier (US 6,185,104 B1, published Feb. 6, 2001), and/or Takayasu (US 5,785,549, published Jul. 28, 1998).

ISSUE

Have Appellants shown reversible error in the Examiner's findings that Grabbe meets the features "the second circuit board is configured to move in a first direction along the first circuit board" recited in claim 9 and a

mechanism configured to move or bias a circuit board or an electrical connector on a circuit board along a curved path as required by claims 18 and 26? We decide this issue in the affirmative.

RELEVANT FINDINGS OF FACT (FF)

1. Grabbe teaches that its daughter board 8 may be connected to the conductors on the underside 12 of the mother board in a perpendicular direction. (Grabbe, col. 3, ll. 5-24 and Fig. 1).
2. Grabbe teaches a daughter board 8 having electrical conductors 4 to contact terminals 18 contained in the insulated housing 20 via cams 120 (Grabbe, col. 2, ll. 13-37, and col. 3, ll. 8-16, and col. 6, ll. 9-27, and Figs. 1, 3, and 5).

PRINCIPLES OF LAW

Under 35 U.S.C. § 102, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987).

“Inherency...may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” *In re Oelrich*, 666 F.2d 578, 581 (CCPA 1981)(quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214 (CCPA 1939)). “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of

the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1463-64 (BPAI 1990)(citations omitted).

ANALYSES AND CONCLUSIONS

With respect to claim 9, the Examiner finds (and illustrates on page 8 of the Answer) that "Grabbe discloses that the second circuit board (8) can move in a first direction along the first circuit board (14)." On this basis, the Examiner determines that Grabbe teaches that its daughter board is configured to move in a direction along the mother board as required by claim 9. (Ans. 8). We disagree.

While Grabbe broadly teaches that its daughter board (second circuit board) may be connected to the conductors on the underside of the mother board (first circuit board) in a perpendicular direction, the Examiner directs us to no express teaching in Grabbe that its daughter board is configured to move in a direction along the mother board as required by claim 9. In this regard, we note that the Examiner's finding, portrayed in the figure on page 8 of the Answer that allegedly shows the daughter board moving in a direction along the mother board via a directional line added by the Examiner, is based on the mere possibility of such movement and thus is speculative and insufficient to establish the inherency of such movement. The Examiner does not provide any reasoning to support such a determination.

Thus, because the Examiner does not direct us to any persuasive teaching in Grabbe that expressly or inherently discloses the disputed claim feature, we find that Grabbe, as applied by the Examiner, does not anticipate claim 9.

With respect to claims 18 and 26, the Examiner finds that Grabbe teaches a mechanism configured to move or bias a circuit board or an electrical connector on a circuit board along a curved path as required by claims 18 and 26 because "the first connector (4) of Grabbe can rotate around a pivot structure and along a curved path." (Ans. 4, 11, and 14). We disagree.

While Grabbe broadly teaches a daughter board 8 having electrical conductors 4 to contact terminals 18 contained in the insulated housing 20 via cams 120, the Examiner directs us to no express teaching in Grabbe of a mechanism configured to move or bias a circuit board or an electrical connector on a circuit board along a curved path as required by claims 18 and 26. (FF 2). In this regard, we note that the Examiner's finding portrayed in the figure on page 10 of the Answer that allegedly shows the daughter board 8 moving in a curved path via a curved line added by the Examiner is mere speculation. The Examiner does not provide any reasoning to support a finding that Grabbe's circuit board inherently moves in a curved path.

Thus, it follows that Appellants have shown reversible error in the Examiner's findings that Grabbe meets the features "the second circuit board is configured to move in a first direction along the first circuit board" recited in claim 9 and a mechanism configured to move or bias a circuit board or an electrical connector on a circuit board along a curved path as required by claims 18 and 26.

Because the Examiner relies on, *inter alia*, the findings relating to claim 9 for all of the § 103(a) rejections on appeal and does not provide any

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findings as to how any of the other cited prior art references would meet the disputed claim feature, we reverse all of the rejections made by the Examiner.

ORDER

In summary, all of the rejections made by the Examiner are reversed.

REVERSED

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